



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Masaki ICHIHARA

Title: REWARDING METHOD
CORRESPONDING TO OBJECT
SELECTION ON WEB PAGE
AND SERVER FOR USE WITH
REWARDING METHOD

Appl. No.: 09/822,274

Filing Date: 04/02/2001

Examiner: Champagne, Donald

Art Unit: 3688

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

This communication is responsive to the **Final** Office Action dated December 31, 2008, concerning the above-referenced patent application.

Claims 1-41 are now pending in this application.

Rejection under 35 U.S.C. § 103

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,794,210 to Goldhaber et al. ("Goldhaber") in view of U.S. Patent No. 5,913,304 to Rakavy et al. ("Rakavy"). Applicant respectfully traverses this rejection for at least the following reasons.

As an initial matter, applicant notes the Examiner's comments in paragraph 13 on page 4 of the Office Action:

Applicant denies the rejection without distinctly and specifically pointing out the supposed errors in the examiner's action. It is not sufficient to point out the supposed errors in the reference. For example, on p. 11, applicant argues, "Goldhaber provides no teaching of applicant's specifically recited log . . .". However, para 5 of the rejection mailed 16 July 2008, which is produced as para. 3 above, explicitly states that Goldhaber et al. has a teaching "which reads on the recording an event log". Applicant's failure to address this and other supposed errors in the examiner's action fails to comply with 1.111(b). The last rejection is accordingly repeated and made final. (emphasis in original)

Applicant submits that the errors in the Examiner's action of July 16, 2008 regarding the rejection under 35 U.S.C. § 103(a) were addressed in the Amendment filed on September 22, 2008 by pointing out the deficiencies in the references upon which the rejection is based. The Examiner's action rejected claims under 35 U.S.C. § 103(a) based on certain references, and pointing out the deficiencies in the references in suggesting all of the features of the claims points out the error of such a rejection in the action.

Moreover, as discussed in more detail below, it is correct that Goldhaber provides no teaching of applicant's specifically recited log, i.e. an event log with all of the features as required by independent claim 1 or independent claim 25. To the extent that the Examiner in paragraph 3 of the Office Action suggests otherwise, the Examiner is incorrect.

Furthermore, the Examiner has failed to specifically address applicant's arguments regarding the deficiencies of Goldhaber and Rakavy in the Amendment filed on September 22, 2008. Accordingly, applicant reiterates the arguments below, and requests the Examiner to address the arguments.

Independent claim 1 is directed to a rewarding method corresponding to a keyword object which is selected on a web page. Goldhaber and Rakavy fail to suggest at least the features of "(c) recording an event log correlating an identifier of the user, an identifier of the selected keyword object, date of selection and an event that the keyword object has been selected, when the server detects that the user of the user terminal unit has selected the keyword object," and "(d) determining whether or not the number of keyword objects

recorded in the event log exceeds a first predetermined value within a predetermined time period,” as recited in claim 1.

As noted in the Amendment filed on December 3, 2004, the event log records not only the date of selection of a keyword by a user, but also the date and time on which the selection was made. The selection of a key word within a predetermined time period (as, for example, one month) results in accumulation of certain number of points for every key word selected. Key words which were selected outside of the predetermined time do not count in the point accumulation and thus do not count in the reward process (See, for example, instant specification, page 21, lines 1-19).

In contrast to claim 1, Goldhaber presents rewards immediately upon the user clicking on the “CyberCoin” and after the user has reviewed the advertisement and answered any questions or other information required by the advertiser. As stated in Goldhaber:

Upon successful completion of this process, an amount of digital currency may be deposited into the consumer’s digital cash repository 126, or alternatively, the consumer’s account may be credited and the advertiser’s account debited by financial clearing house computer 108 (Col. 16, lines 12-16).

Goldhaber provides no teaching of applicant’s specifically recited event log which includes not only the identifier of the user and the identifier of the selected object but also the date of selection. Moreover, Goldhaber does not provide any teaching of determining whether or not the number of objects recorded in the event log exceeds a predetermined value within a predetermined time period. Thus, Goldhaber fails to disclose or suggest features (c) or (d) as recited in claim 1.

The Examiner apparently now recognizes that Goldhaber fails to disclose features (c) or (d), but now cites to Rakavy at col. 7, lines 51-53, col. 12, lines 61-65, and col. 13, lines 2-3 for curing the deficiencies of Goldhaber with respect to (c). Applicants respectfully disagree. The cited sections of Rakavy merely disclose a Scheduler 265 that schedules the display of time dependent ads, a Feedback Manager 220 that sends feedback information, such as the time of display, back to an Advertising System Server 600, and calculating an advertiser’s charge based on the feedback information.

Rakavy does not suggest modifying Goldhaber to include feature (c) of “recording an event log correlating an identifier of the user, an identifier of the selected keyword object, date of selection and an event that the keyword object has been selected, when the server detects that the user of the user terminal unit has selected the keyword object.” Rakavy does not record a date of selection of a keyword object by a user, but merely disclose the scheduling of a time dependent advertisement. Moreover, while Rakavy discloses charging an advertiser for the length of time an ad was displayed, Rakavy says nothing about providing rewards to a user based upon keyword object selection. Thus, even if combined, Goldhaber and Rakavy do not suggest feature (c).

The Examiner recognizes that neither Goldhaber and Rakavy disclose feature (d) of “determining whether or not the number of keyword objects recorded in the event log exceeds a first predetermined value within a predetermined time period,” but argues that such a feature would have been obvious. Applicants respectfully disagree.

Goldhaber emphasizes that rewards to a user should be immediate (See col. 10, lines 63-65), and thus teaches away from a system where a number of keyword objects must be recorded within a certain time period before a reward is offered.

While Rakavy discloses that an advertiser be charged for the length of time an ad is displayed, Rakavy says nothing about determining a reward based on user selection of a number of keyword objects within a certain time period.

Finally, the Examiner has provided no evidentiary basis for feature (d) being disclosed in either Goldhaber or Rakavy, but merely asserts this feature would have been obvious. If the Examiner maintains this rejection, applicants request the Examiner to provide such evidentiary support.

Independent claim 25 has features corresponding to those discussed above with respect to claim 1 in the context of a server, and is patentable for analogous reasons.

The dependent claims are patentable for reasons analogous to their respective independent claims, as wells as for further patentable features recited therein.

It is thus submitted that the application is now in condition for allowance and an early indication of same is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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